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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,528	03/08/2002	John Butler	08203.0018	8902

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Garrett & Dunner, L.L.P.  
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Washington, DC 20005-3315

EXAMINER
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LEUBECKER, JOHN P

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 10/02/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/092,528

Applicant(s)

BUTLER ET AL.

Examiner

John P. Leubecker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25, 27, 29-35, 37-41, 44-70 and 72-74 is/are rejected.
- 7) ☒ Claim(s) 26, 28, 42, 43 and 71 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Drawing***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the overtube sections which are releasably mountable to one another (claim 36) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

2. Claim 66 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 66 fails to further limit the claimed structure and appears to be reciting an intended use or method step. It is therefore confusing as to how this claim affects the scope of the *apparatus* as claimed.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Because of the numerous, overly broad claims directed to an exhausting number of individual features, the Examiner has only provided a discussion of the prior art reference below when a clarification of an interpretation is deemed necessary. All other elements or features that are easily found in the references will not be specifically pointed out. Any questions with respect to how a particular prior art reference below reads on the cited claims can be answered with a phone call to the Examiner.

5. Claims 1-8, 11, 13, 19-21, 30-35, 44-47 and 58-66 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Clement et al. (U.S. Pat. 3,908,704).

Clement et al. discloses a corrugated PTFE or copolymer tube. To clarify, the rounded edge on the right side of Figure 1 is being interpreted as a rounded tip mounted to an exterior surface and extending into the lumen.

6. Claims 1-3, 9-19, 30 and 66 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Wendlandt et al. (U.S. Pat. 6,554,820).

For clarification, the Examiner is interpreting Wendlandt's braid (10) as anticipating a mesh and a braid configuration.

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7. Claims 1-3, 9, 11-13, 19, 20, 22-25, 27, 29-31, 44-46, 53, 57 and 66 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yoon (U.S. Pat. 5,797,888).

It is noted that Applicant defines "film material" as silicone.

8. Claims 1-9, 19, 21-23, 29, 30, 32-35, 37-41, 44-48 and 59-66 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kruger (U.S. Pat. 5,454,364).

9. Claims 1-3, 9, 11-14, 16-19, 30 and 48-52 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Wendlandt (U.S. Pat. 6,517,477).

10. Claims 1-3, 9-12, 19, 20, 30, 31, 53-57 and 66 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Chikama (U.S. Pat. 4,332,242).

The threaded coupling between the flange and the tube constitutes an adjustable coupling.

11. Claims 1-7, 9, 19, 22, 23, 30, 67-70 and 72-74 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bauerfeind et al. (U.S. Pat. 5,337,733).

Bauerfeind et al. shows the method steps as claimed in Figures 3a-3f. Note col.6, lines 49-57 which describe the colonoscope being removed.

***Allowable Subject Matter***

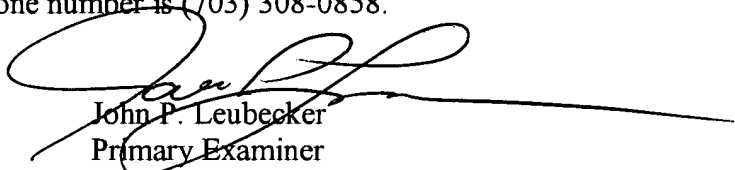
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12. Claims 26, 28, 36, 42, 43 and 71 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (703) 308-0951. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



John P. Leubecker  
Primary Examiner  
Art Unit 3739

jpl